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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/811,579	03/20/2001	Kenneth A. Welchman	20002.0093	1383

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EXAMINER	
NGUYEN, SANG H	
ART UNIT	PAPER NUMBER
2877	

DATE MAILED: 08/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/811,579	WELCHMAN ET AL.	
	Examiner	Art Unit	
	Sang H Nguyen	2877	

-- The MAILING DATE of this communication app ars on the cover sheet with the correspond nc address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 May 2002* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *14-44* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *14-44* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Response to Amendment

The present Office action is made in response to Amendment/A filed on 06/05/02 in Paper # 5. It is noted that the present application contains claims 14-440 and claims 1-13 have been canceled by the Amendment/A filed on 06/05/02.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 14-16, 18-20, 23-25, 27-28, 30-34, 36-39, and 42-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kumagai (U.S. Patent No. 6,031,933) in view of Yoshikawa et al (U.S. Patent No. 5,286,532).

See the reasons as indicated in the previous office Action 12/26/01 in Paper No. 3.

3. Claims 17, 26, 35, 40-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kumagai and Yoshikawa et al as applied to claims 14-16, 24-25, 31-33, and 37-39 above, and further in view of Tao (U.S. Patent No. 5,732,147).

See the reasons as indicated in the previous office Action 12/67/01 in Paper No. 3.

4. Claims 21-22, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kumagai and Yoshikawa et al as applied to claims 14, 19-20, and 24 and 28 above, and further in view of Yamada (JP 08 309 262).

See the reasons as indicated in the previous office Action 12/26/01 in Paper No. 3.

Response to Arguments

5. Applicant's arguments filed on 06/05/02 have been fully considered but they are not persuasive.

a. Applicant's remarks argues, in pages 9-11, that there is no suggestion to combine the references, the examiner recognize that obviousness can only be established by combining or

modifying the teaching of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F. 2d 1071, 5 USPQ2d 1596 (Fed Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (fed. Cir. 1992). In the case, the different between Kumagai and/or Yoshikawa et al and/or Tao and/or Yamada, for example, Kumagai discloses defects of surface of a golf ball before applying coatings or marks of the golf ball according to a method and apparatus for inspection of the golf ball while the treatment surface of golf ball with a method for producing golf ball by coating film on the surface of the golf ball in Yoshikawa et al. Furthermore, Kumagai not only teach coating material such as characters, marks representing a trade name and player number on the surface of golf ball but also detecting defects of the surface of the golf ball before coating materials with detecting defects on the surface of the golf ball (col.10 lines 15-27 and figures 11A-11D), however, Kumagai does not teach that treatment surface of the golf ball in his invention because treatment surface of the golf ball is considered to be inherent such as coatings, marks, etching, or trade name of the golf ball. Thus, it would have been obvious to one having ordinary skill in the art to modify the invention of Kumagai by the treatment surface of the golf ball method as taught by Yoshikawa et al. Also, when the references (Yamada and Tao) are considered in combination, the recitation of claims would have been obviously suggested.

c. Applicant's remarks argues, in page 8, that Kumagai fails to teach applying a surface treatment to a game ball and determining conformance of the surface treatment to predetermined

standard. It is agreed that Kumagai does not teach applying a surface treatment to golf ball, however, this limitation is taught by Yoshikawa et al at col.1 lines 29-38. Moreover, Yoshikawa et al does not discloses determining conformance of the surface treatment to predetermined standard (or threshold), Examiner is agreed with applicant, but Kumagai teaches that this limitation in col.9 lines 30- 67 and col.10 lines 1-14 and figures 1-6. Thus, when the references are considered in combination, the recitation of claims would have been obviously suggested.

For the reasons set forth above the arguments, it is believed that the rejection of the claims 14-44 under 35 U.S.C 103 is proper.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Sang Nguyen whose telephone number (703)308-6426. The examiner can normally be reached on Monday through Friday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Frank Font, can be reached on (703)308-4881. The fax phone number for the organization where this application or proceeding is assigned is (703)308-7722 or 7724.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0956.

SN

Nguyen/ sn

July 30, 2002

Frank G. Font
Supervisory Patent Examiner
Technology Center 2800